
IN THE 20
United States
Circuit Court of Appeals,
FOR THE NINTH CIRCUIT.

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| James W. McGhee and Edward C. Jinks trading as McGhee & Jinks, <i>Appellants,</i> | } |
| <i>vs.</i> | |
| LeSage & Company, Inc., a corpora- tion, <i>Appellee.</i> | } |

BRIEF FOR APPELLEE.

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BRIEF FOR APPELLEE.

In this appeal from the final decree of the District Court for the Southern District of California, Southern (now Central) Division [Tr. 14], which dismissed the bill of complaint, opinion by Judge James [Tr. 13], there is involved a patent to James W. McGhee, of plaintiffs-appellants, No. 1,475,306, *for a bent piece of wire*, so conformed as to produce two loops, one loop to be hung over a curtain rod or pole and the other loop to be engaged with a curtain or drapery, thus sustaining the latter or suspending it from such rod. The end of the bent piece of wire which extends into the latter or curtain-sustaining

loop is pointed or sharpened to be readily passed through the fabric [Tr. 83]. The alleged invention of this patent was not the first attempt of McGhee to bend a piece of wire into shape for supporting a curtain or drapery. In 1919, over three years before he filed his application for the patent in suit, he applied for another patent which was issued March 23, 1920, No. 1,334,661 [Tr. 64]. That device had similarly two main loops and a pointed end for passing through the fabric, one loop passing over the curtain rod and the other accommodating the fabric. This earlier patent of McGhee's thus contains every element of the bent wire formation shown in the patent in suit, with the additional element of a spring coil, 3, tending to pinch the fabric between the finger, 1, and the arm, 4 [middle of page 65, Tr.]. In this earlier form the other end of the wire was sharpened or pointed. There was absolutely no novel *conception* in the device of the second McGhee patent. In effect it amounted to merely an elimination of the spring coil, 3, and sharpening the other end of the wire. The second McGhee patent taught nothing new over the first McGhee patent. While the first McGhee patent would have been as pertinent to the second McGhee patent had it been the patent of someone else, it is interesting to study in connection with the patent in suit in the particular respect that *it cancels out of the picture any possible novel conception by McGhee in his devising of the bent wire of the patent in suit.* And we shall see that much further prior art was even closer in detail to the bent wire of the patent in suit than was McGhee's earlier effort.

Conception Necessary to Invention.

In a decision by the Circuit Court of Appeals, First Circuit, *Thacher v. Inhabitants of Town of Falmouth*, 241 F. R. 869, in which the appellate court affirmed a decree for defendant, there was involved a patent for an improvement in concrete arches, including pairs of metal bars in the arch (p. 870). The court said, at page 874, on this question of mere mechanical skill or engineering in contradistinction from inventive thought:

“We are unable, as was the District Court, to find inventive thought going beyond mere mechanical improvement involved in any advance made by the plaintiff upon the methods of concrete arch reinforcement whose use had become open to the public, as above. As is said in the opinion of the learned District Judge:

‘Variations of size of wires do not constitute invention; widening the spaces between the bars, to enable an engineer to use coarse concrete, is not invention; dispensing, in whole or in part, with unessential parts, is not invention; producing economy in bridge building by consolidating numerous small bars into one large bar, cannot be said to be invention. These things are mechanical; they relate to good engineering; they do not disclose inventive thought.’

Finding no error, therefore, in the conclusion of the District Court that the claims in suit are invalid, the patent not disclosing patentable invention, we have no occasion to consider the question of infringement by the defendant.”

Inventive thought with a conception is necessary to all inventions. First, the inventor must conceive of steps to be taken or employed, and then embody the conception in actual or concrete form. There was nothing remaining

over and beyond the first McGhee patented device which could constitute conception or inventive thought as entering into or sustaining and devising of the second patented McGhee hook. The same is true with respect to the second patented McGhee hook and the rest of the prior art.

That there could be no inventive conception in bending a piece of wire into the shape of that of the patent in suit, which is very analogous to that of an ordinary pot hook, is likewise within the reasoning of the Circuit Court of Appeals for the Second Circuit in *Fernand v. Oneida National Chuck Co.*, 174 F. R. 1020. The decision *per curiam* is brief and is as follows (p. 1021):

“Appellant criticizes the opinion of the Circuit Court on the ground that it ‘took judicial notice’ of the thill couplings of the prior art. But it was not necessary to find any prior art other than such as the patent itself discloses. It is manifest from the patentee’s own statements that all he did was to bend over or clinch the ends of the wire link, so as to prevent their slipping out of the apertures in which they were inserted. Of course, to do this he had to enlarge the interior of the aperture sufficiently to turn them. No amount of evidence, expert or other, could possibly raise such an obvious expedient to the dignity of an invention. The decree is affirmed, with costs.”

So much at the outset in support of the memorandum opinion of Judge James [Tr. p. 13], in which he said “* * * the court finds that said patent of plaintiff is invalid in that it discloses *no invention* over devices made and marketed prior to the date of the patent application, and that plaintiff’s device was not new in the art; * * *.” It is also true that devices of prior patents and publications, irrespective of the making or marketing of such devices, support the holding that the patent discloses “no invention,” and these further things support the finding that it “was not new in the art.” (Italics ours.)

Conception Lacking—No Invention.

This court some years ago, in *Towne Steering Wheel Co. v. Lee*, 199 F. R. 777, opinion by Your Honor Judge Gilbert, affirmed a decree for defendant entered upon the sustaining by the late Judge Wellborn of a demurrer to the appellant's bill which brought suit for the infringement of a patent for "a steering wheel for auto-vehicles." The claims were for a steering wheel having a rim with a smooth outer surface and an indented inner surface. The purpose of the alleged invention was to permit the fingers of the operator to tightly grip the wheel and hold the same from slipping. The question presented on the appeal, said Your Honors, page 778, was "whether the court below erred in sustaining the demurrer to the bill for want of patentable novelty in the device described in the patent." The opinion goes on to state:

"The appellant argues that regard should be had to the allegations of the bill—which must be taken as true—averring that the trade and the public have generally accepted and acquiesced in the validity and scope of the patent, and that the invention has been extensively practiced and has gone into great and extensive use, and that those allegations made it incumbent upon the court below to allow the appellant the opportunity of proving those facts in aid of the presumption of novelty which arose from the issuance of the patent. That argument would be persuasive if there were room for doubt on the question of the novelty of the device. But we find no room for doubt. In *Dunbar v. Meyers*, 94 U. S. 187, 24 L. Ed. 34, it was said: 'The Patent Act confers no right to obtain a patent except to a person who has invented or discovered some new and useful art, machine, manufacture, or composition of matter, or some new and useful improvement in one or the other of those described subject-matters.' It is common knowledge that the expedient of roughening and

corrugating the surfaces of handles of various implements is very old, and instances may be found in the handles of tennis rackets, fishing rods and baseball clubs, and that the handles of swords and knives from time immemorial have been indented on the inner side so as to render more firm the grasp of the fingers. In Appleton's Encyclopedia of Applied Mechanics, there appears a cut showing a round indented circular handle of a valve with an indented outer surface so made for the purpose of giving a firmer handhold upon the handle."

And so, in the case at bar, it is common knowledge that wires may be bent into any sort of serviceable shape for hooking and engaging objects and fastening objects together and may be sharpened to produce penetrating ends. This is how farmers use hay-wire. In an inconceivable number of forms wire has been twisted and bent to adapt itself, by its ready pliability, to service for multitudinous ends and purposes. Had it not been for McGhee's first drapery hook attempt plus all the other prior art, no invention would have inhered in bending a piece of wire into oppositely directed loops and sharpening one of the wire ends. There was no novelty in the shape, no novelty in function and no novelty in performance over a wide range of expedients made of bent wire or rods previously used, and extending in kind from fish hooks to pot hooks.

So much to stress in limine the fatal *character* of the thing which the Patent Office was persuaded to recognize by patent. It is neither an art, machine, composition of matter nor an article of manufacture capable of having the quality of *invention* required under the statute of all patentable things, in view of notoriously old wire bendings.

File Wrapper and Contents of McGhee Patent.

When we turn to the record of the application for the patent in suit [Tr. p. 66] we are still more amazed that this piece of bent wire could be recognized as arising to the dignity of invention. Four claims were originally presented [Tr. p. 72]. All of them were rejected by first action of the Patent Office, British patent to Harrison [Tr. p. 94] (cut opposite Tr. p. 97) being cited against the claims. Harrison plainly shows the two loops in a piece of wire disposed and arranged as does McGhee, the device being a curtain hook, and one end of the wire, adjacent to the curtain-supporting loop, being pointed. The only appreciable difference between McGhee and Harrison is that Harrison puts in a couple of extra bends in the wire, one of same tending to tightly pinch the fabric. Elimination of these bends would certainly not amount to invention. In the reply to this rejection McGhee's attorney cancelled claims 1 and 4 and in the remaining claims inserted the word "spring" before the word "loop" [Tr. p. 76]. This could not constitute invention because every bent wire has inherent spring qualities. Of these two remaining claims, claim 1 was next rejected and claim 2 allowed. After further correspondence claim 1 was again rejected. It was then ordered cancelled by McGhee's attorney and the application was then allowed with its single claim, which became the single claim of the patent. It will be noted that the Harrison patent was the only prior art cited by the Patent Office. We admit that it was close enough, and contend it was sufficient to warrant the rejection not only of the three claims that were cancelled, but also of the fourth claim which became that of the patent in suit. We do

not understand how the claim was allowed over the rejected claims. Compare it with original claim 2 as amended. The only difference consists of the following language:

Cancelled Claim 2.

one side of said hook constituting a shank, the end of the shank being bent to form a spring loop, an arm extending upwardly from the spring loop and disposed adjacent the shank and terminating near the hook bend,

Claim of Patent.

to provide an arch, a hook end and a shank portion, the end of the shank portion being bent to form a spring loop, and an arm extending upwardly from the loop disposed along the outer edge of said shank and terminating adjacent the junction between the shank and arch,

We contend that the language in each instance means the same thing in all fairness, and that there is nothing in the claim of the patent *in substance* that was not present in the language of cancelled claim 2. Under the settled rule, acquiescence in the rejection of a claim and cancellation of said claim prevent the patentee from asserting for any other claim the meaning and scope of the cancelled claim. *Schultheiss Co. v. Phillips*, 264 F. R. 971, a decision of this court, citing other decisions by it. The claim must be strictly construed. And being the same in substance as original claim 2, we contend that, in cancelling original claim 2 as amended, together with the cancellation of the other original claims, McGhee struck out from under the remaining claim all substance for which he might otherwise, by appeal, have made contention for patentability, had there been any structural

distinction between his device and the prior art, or had there been present anything patentable in nature and kind.

As the Patent Office overlooked the earlier McGhee patent and the other prior art to be discussed later, and did not indeed consider Harrison sufficient in and by itself to meet the claim of the patent, then the burden was upon the lower court (and the lower court accepted such burden) of considering *de novo* those examples which the Patent Office overlooked. We contend here as we did before the lower court, that the whole prior art meets every slightest particularity of the claim which was allowed, unless it be with respect to dimensions totally inconsequential.

Real Anticipation.

We, therefore, believe that the lower court quite properly could have gone further and found the patent in suit absolutely anticipated as well as invalid for want of invention. While the legal distinction exists and is technically proper, we believe it need not have been drawn in the present case, and that the single claim of the patent in suit is totally void both for want of invention and anticipation.

Prior Art.

Defendant put before the court quite extensive prior art in addition to the single citation, Harrison, made by the Patent Office. We have already adverted to the earlier McGhee patent which in structure, nature, function and purposes so thoroughly occupied the field of the present alleged invention that there was nothing left to

warrant issuance of the patent in suit. When to this prior art is added the Harrison patent and the other prior devices about to be discussed, we can entertain no doubt that the Patent Office would certainly have refrained from issuing the patent in suit with its single claim had such further prior art come to its attention or been discovered by it.

We might take up these other examples in the order in which they appear in the transcript. The first of these is British patent to French, Defendant's Exhibit K [Tr. p. 87], No. 28,885 of 1912, many years before both of the McGhee attempts. The drawing [opposite Tr. p. 93] of this curtain hook shows clearly a pointed length of wire with two main loops, having the same principle, mode of action and arrangement of members as in the patent at bar. If the court will compare Fig. 6 with Fig. 2 of the patent in suit, this will be apparent. It may be truthfully said that all that McGhee did was to eliminate some of the bends and curvatures in the French device. No new feature or accomplishment is imported by such elimination.

Skipping now over Harrison, *supra*, we come to the Timmis British patent No. 15,079 of 1910, also an early patent. The cut is opposite Tr. p. 103. And this device is also for the identical purpose and use that the McGhee device serves. We suggest comparison of Fig. 6 of this cut with Fig. 2 of the McGhee patent. We find the opposite bends and almost identical formation. The loop 5 goes over the pole or rod such as shown in Fig. 1, and the curtain is suspended by the other loop by means of loop 11 stitched to the curtain. Whether the curtain

have a loop on it as in Timmis or the curtain be impaled upon the hook by passing the pointed end through the latter, as in Harrison, for instance, is matter of selection and choice.

Next in order is the hook tag of Fay, U. S. patent issued over sixty years before McGhee's activities, No. 15,226 of July 1, 1856. The tag is carried by a loop in the hook E and by means of a sharpened point, the material to which the tag is to be applied is impaled upon the hook. Obviously, this device could be strung onto a curtain rod and have the identical performance of the McGhee device. There is a substantial identity of structure.

The Gunn device [cut opposite Tr. p. 106b] is not for the identical purpose of the McGhee device, but has a bent metal formation quite similar, as may also be said of the Riggs device [opposite Tr. p. 109a]. Both Gunn and Riggs are of considerable antiquity. The catch pin of the Nash patent of 1889 [cut opposite Tr. p. 112a] shows a similarly bent piece of wire having oppositely directed loops with one end pointed. Similar formation is shown in the Savage skirt hook patent, issued in 1903 [cut opposite Tr. p. 115a]. Similar sharpened and bent metal formation is shown in U. S. patent to Lacoïn of 1904 [cut opposite Tr. p. 119b], and the same structural idea of opposite loops in bent wire having one end sharpened is found in Bliemeister U. S. patent of 1916 for a holder or means of suspension. [Cut opposite Tr. p. 123.] In 1913 there was issued the Ashmoe U. S. patent [cut opposite Tr. p. 129], which is a drapery suspension pin for curtain rings. This patent discloses a

bent wire formation for hooking on to curtain rings on a curtain pole 70 with sharpened ends or “prongs” for passing through the fabric of the curtain. It will be noticed that the specification of this patent [Tr. p. 131] points out what is true with respect to almost all of this prior art, to-wit, that the hooks or devices can be engaged with the curtain fabric without any sewing, *and this idea was definitely and conclusively not new with McGhee.*

Now this Ashmore patent No. 1,069,999 is referred to in the depositions taken in the case, commencing with the deposition of Mr. Vroom [Tr. p. 27], he being sales manager of the H. L. Judd Company, manufacturers of the device complained of in this suit, and with that concern since the year 1888 [Tr. p. 28]. That the Judd Company is to pay for defending the present suit is admitted by Mr. Vroom [Tr. p. 31], he stating that he is acquainted with the defendant. The defendant bought its hooks complained of in this suit from the said Judd Company, a corporation domiciled in New York [Tr. p. 26]. Instead of suing the manufacturer, the present defendant, doing business in California, was sued as a dealer handling the product made by the Judd Company. Counsel for appellee were retained by the H. L. Judd Company.

Beginning at transcript page 30, Mr. Vroom discusses the hook of this Ashmore patent No. 1,069,999, stating that the Judd Company began making the hooks like Defendant’s Exhibit E, the Ashmore hook, shortly after the issuance of the Ashmore patent, and that they were on the market before 1918 and sales were made before 1916 and that the Judd Company manufactured hooks like Exhibit E for more than eight years and offered

them for sale all over the United States and illustrated them in catalogues sent to all parts of the United States, and that numerous sales were made in this country. These hooks were sold under a license from Mrs. Ashmore, and this license between Edith Ashmore and the Judd Company, dated January 14, 1914, is in evidence as Defendant's Exhibit G, Ashmore Royalty Contract, and was signed for the Judd Company by John Day, president.

So a drapery suspension pin or hook *not to be sewed on, but to be passed into the curtain and hold it in a loop at the lower end of a pointed pin, with a loop for suspension*, was sold extensively in this country many years before McGhee applied for the patent in suit and by the very manufacturers of the device now complained of.

We now come to a consideration of certain foreign catalogues as publications, to-wit, catalogues published many years before the end of the last century in Great Britain, by James Whitefield & Sons of Birmingham, England, and Tonks, Ltd., likewise of Birmingham, England, and also by one George Whitehouse of Birmingham, England. Page 62 of the Tonks catalogue appears opposite transcript page 133 and page 5 of the Whitehouse catalogue appears opposite transcript page 134. Copyright records of the British Assistant Keeper of the Public Records, with respect to the Tonks catalogue, and the consular certificate with respect to the signature of such Assistant Keeper, appear at transcript pages 133 and 134. The Tonks catalogue is in evidence as Defendant's Exhibit A [Tr. p. 21] and the Whitefield catalogue is in evidence as Defendant's Exhibit C [Tr. p. 24], and the Whitehouse catalogue is in evidence as Defendant's Ex-

hibit B [Tr. p. 23]. Testimony regarding these catalogues appears beginning at transcript page 19, from witness John Day, who says he went over to Birmingham, England, in 1883 and purchased merchandise from the Tonks Company and during the course of business received the catalogue, Exhibit A, and that it has been in the possession of the Judd Company for more than ten years. So that the catalogue was not only published in Great Britain and of course distributed as catalogues are, but it was referred to and used in this country, that is, the specific catalogue Exhibit A [Tr. pp. 20, 21]. In 1881, Mr. Day says, he went to England and purchased merchandise from George Whitehouse, who published the Exhibit B catalogue, and that Judd Company purchased a great many goods from that firm for many years. He says that Exhibit B contains a letter written by Whitehouse soliciting business and quoting prices on goods illustrated in the catalogue, and he saw the book when it came to the Judd Company, which was in 1882. The book has, therefore, been in possession of the Judd Company a great many years and 'way back into the last century. With respect to the Whitefield catalogue, Exhibit C, he says the book has been under his personal observation for over twenty years. Exhibits A and C and also the Whitehouse catalogue, Exhibit B, of 1882, were used by the Judd Company to select merchandise which they wished to order from the proprietors. He refers to the order book, Exhibit D, and to orders from Whitefield and Tonks and Whitehouse. Mr. Vroom [Tr. p. 27] corroborated Mr. Day, and stated that in 1911, over ten years before McGhee applied for the patent in suit, the keys to a private closet were turned over to him and in

it were the books, Exhibits A, B, C and D, and that they reposed there until two or three years before he testified. He says [Tr. p. 29] that the order book, Exhibit D, contains a copy of foreign purchases by the Judd Company with references to purchases from Tonks and Whitehouse and Whitefield; and, while he states that he did not find anything in the catalogues that gave *him* the inspiration to manufacture a drapery hook like Defendant's Exhibit 100, he had nothing to do with the manufacture of the hooks charged to be infringements. Mr. Edsall was in charge of the manufacturing end [Tr. p. 33]. It does not make any difference anyway, because there was no invention in the device whatsoever of McGhee or anyone.

Testimony begins at transcript page 45 with respect to the publication of the Whitefield, Whitehouse and Tonks catalogues. Wright says [Tr. pp. 47, 48] that the Tonks catalogue (Exhibit A), referring particularly to page 62 thereof, was issued in 1895 and circulated in 1895 and for some years thereafter. Whitehouse testified [Tr. pp. 45, 46] that Exhibit B, Whitehouse catalogue, particularly page 5 thereof, was a catalogue of general issue to customers, contained illustrations of the goods sold by George Whitehouse, and that the book was printed prior to 1892 and was widely distributed by George Whitehouse & Co. to practically all customers of the firm prior to 1920.

Obviously, this testimony of Wright and Whitehouse to show distribution of these catalogues, Exhibits A and B, clearly establishes their publication and distribution in Great Britain and wherever their customers resided. When

the evidence of these witnesses was received in the court notice was filed with the clerk of the court. The foreign testimony was objected to but without avail, the court stating in his opinion [Tr. p. 13] that "certain objections having been made to the introduction of trade catalogues and pages therefrom, the court having first considered such objections in connection with depositions taken in England, which are ordered filed, and said objections are overruled with an exception to plaintiffs, * * *." The catalogues were thoroughly proven as to their original publication and distribution; and if Your Honors will refer to the central field of page 62 of the Tonks catalogue, opposite transcript page 133, in all substance the identical McGhee patent drapery hook (No. 200) will be found there, as well as in the two cuts in the lower right-hand corner of the Whitehouse catalogue, page 5, opposite transcript page 134 (690 and 691).

All such being the case, it remains practically unnecessary to consider in any detail the question of

No Infringement.

It will be found, if minute attention be given to defendant's alleged infringing hook, that there are slight differences between the specific terms of the claim, based upon the specification, and the structure of defendant's hook. The claim must be strictly construed, particularly because of the language of the specification [Tr. pp. 84 and 85]. It is required that the point be projected slightly beyond the junction of the shank and arch, with pointed arm against the shank, so that too much drapery will not be pierced. Plaintiff has not made its hook this way, and defendant does not. The patent may, therefore, be

said to be a paper patent under *Henry v. Los Angeles*, 255 F. R. 769 (C. C. A., 9th Cir.) The exact thing called for by the claim, based upon the specification, is used by neither plaintiffs nor defendant. But there is no profit to be derived in speculating about these little differences in wire bending, *because the whole substance of the McGhee patented device and also of defendant's device is so clearly found within the archives of the prior art and particularly in the Tonks and Whitehouse catalogue devices.* If anybody could spell invention over the Whitehouse catalogue, for instance, cuts 690 and 691, to support patentability of the device described and pictured and claimed in the McGhee patent in suit, he would be an excellent friend, if an examining official in the Patent Office, for all unoriginal persons desiring to obtain patents with the element of novelty and invention absent from the subjects of the applications. The Patent Office officials often err, but they never take such an unsustainable attitude as that.

The abortive and feeble attempt to make it appear that McGhee had invented something because of the non-sew-on idea of drapery hooks is taken from under the very feet of plaintiffs by the prior art, and more particularly by the earlier non-sew-on drapery hook patent of McGhee himself [opposite Tr. p. 63a].

Before the lower court the issues were confined in the main to the question of non-invention.

Certainly catalogues, such as the Tonks and Whitehouse, are prior publications, and in support thereof we have the high authority of the Circuit Court of Appeals of the Sixth Circuit in a patent suit under a design patent,

The commercial success of any device cannot import patentability where that is not present. Judge James was entirely correct in holding the patent void for want of invention, and likewise, we submit, it might have been found anticipated.

Upon the argument we will hand up to Your Honors prints showing the hooks of the patent in suit and of plaintiffs and defendant, and certain prior art devices, such prints being taken from drawings which were handed up to the trial court for convenience in considering the issues.

With respect to the matter of non-invention, we will cite here certain further authorities for the convenient reference of the court.

Walker on Patents, 4th Ed., section 25, page 20, states as follows:

“Sec. 25. It is not invention to produce a process, machine, manufacture, composition of matter or design which any skillful mechanic, electrician, chemist or other expert would produce whenever required.”

Walker then quotes *verbatim* from *Atlantic Works v. Brady*, 107 U. S. 199, opinion by Mr. Justice Bradley. Part of that quotation we requote as follows:

“It is never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax

upon the industry of the country without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.”

Your Honors, in considering a simple alleged invention for a piece of cardboard with flaps to be inserted in fruit boxes for protective purposes, in the case of *California Fruit Exchange v. Blake, Moffett & Towne*, 1928 (not found reported), found there was no invention.

In *Glen Rock Co. v. American Caramel Co.*, 209 F. R. 619, the Circuit Court of Appeals for the Third Circuit, by Circuit Judge Buffington, said, at page 620:

“Giving due regard to all that may be said of Lafean’s device, it is clear to us that it is such an economic and mechanical step as naturally followed in the evolution of an industry, and not such an original, innovating disclosure as makes an inventive act differ from mere mechanical advance.”

The Circuit Court of Appeals for the Second Circuit, in *Allen Auto Specialty Co. v. Baker*, 229 F. R. 424, speaking by Circuit Judge Coxe, said as follows, at page 425:

“The moment the advisability of keeping the rubber tires free from rain was apparent, it would, we think, have occurred to the ordinary mechanic to cover the sections so that the water would pass beyond the inner folds and not be delivered to the inside of the case. It is difficult to imagine a mechanic of ordinary intelligence who would leave the passage open when the obvious and natural thing to do is to cover it.”

It certainly would be obvious to any person desiring to twist a piece of wire into shape to hang it over a curtain

rod and to impale the curtain and suspend it, to make a loop for the rod and a loop to suspend the curtain.

Your Honors, by Judge Morrow, in *Willamette Iron & Steel Works v. Columbia Engineering Works*, 252 F. R. 594, in a case involving a simple improved pulley with a flaring sheave, said, at page 596:

“But, passing by the question of anticipation as presented by these two patents, is there invention in giving a flare to the sides of the opening in the block over the sheave or wheel? It was probably found in practice that with perpendicular sides to this opening a hook or other attachment on the line passing over the sheave or wheel would catch on the one or the other of the sides of the block. If so, what was more simple than to enlarge the opening and give the sides a flare, so that the hook or other attachment would not catch on either side, but would pass freely through the opening in the block on over the wheel? For this change in the construction of the block mechanical skill was clearly sufficient.

The claim is made by the appellee that the object of the flaring sides to the opening of the block in suit was to permit the use of a narrow sheave to save weight and cost, and that the advantage of a wide sheave, as shown in one form of appellant’s block, had been attained by such flaring construction of the appellee’s block with a narrow sheave. This claim is made primarily to point out the difference in two blocks manufactured by the appellant, one with a narrow sheave, claimed as an infringement of the appellee’s patent, and the other with the broad sheave, not claimed as an infringement. Conceding that there is this difference in the two blocks, it does not follow that this feature of appellee’s block is the product of invention.

Here, again, we think the difference in construction is one merely of degree, and not of invention. It is true that the issuance of a patent is of itself presumptive evidence both of invention and patent-

ability; but we think an inspection of the device, as shown by the model and described in the specifications and claims, overcomes this presumption, and, aside from the evidence of anticipation in the Louden and Eby patents, determines that the patent in suit lacks invention.”

The Circuit Court of Appeals for the Sixth Circuit, in *Berger Mfg. Co. v. Trussed Concrete Steel Co.*, 257 F. R. 741, considering a patent for studding and metal lath combination, held such patent invalid as involving elements developed in the prior art. That court, *per curiam*, said, at page 741:

“It must be conceded that the complete combination specified in the claim is not precisely anticipated, that it possessed commercial utility, that it has gone into considerable use, and—more important than all—that metallic studs or supports and metal lath had been used in combination for a number of years and fastened together in different ways without adoption by any one of the specific methods of fastening here disclosed. These considerations make strongly in favor of patentability; but we are compelled to think that they are not sufficient to overcome the conclusions necessarily resulting from the state of the art.”

It will be noted in this case that the court did not find the claim to be “precisely anticipated,” but still found that the lower court was right in dismissing the bill. The claim quoted in the opinion has to do with prongs and bends, as does the patent at bar.

The District Court for the Western District of New York, by Judge Hazel, in *Adt v. E. Kirstein Sons Co.*, 259 F. R. 277, ordered a decree for defendant with respect to several patents relating to eyeglass mountings. The court said, with respect to one patent, at page 280:

“In departing from the combination by adapting additional elements or arranging old elements differently for confining the guard arm or for carrying the inner spiral spring away from the center of the coil outwardly, the patentee made changes or modifications which do not appear to have secured any new advantages or results.”

The court found that the patents had to do with things which failed in “describing anything patentably different from that described in prior patents to which attention is herein directed, excepting perhaps claim 5 of patent No. 1,040,096, which, however, is not infringed by defendant’s mountings.”

The Circuit Court of Appeals for the Second Circuit, in *Boston Pencil Pointer Co. v. Automatic Pencil Sharpener Co.*, 276 F. R. 910, had before it an appeal by defendant from a decree for plaintiff concerning a patent for a chip receptacle for pencil pointers. The decree was reversed, with directions to dismiss the bill. The court said, at page 911:

“Nevertheless commercial success is an unsafe guide to invention unless prior efforts to fill the space be shown (*National etc. Co. v. Bissell etc. Co.*, 249 Fed. 196, 161 C. C. A. 232); and when they are shown, it is not infrequently found that the faculty of invention was not necessary to fill whatever vacancy existed.

Further, it is settled that articles may be new in a commercial sense, when they are not new in the sense of the patent law (*Collar Co. v. Van Deusen*, 23 Wall. 530, 23 L. Ed. 128), and novelty, however great, can never be put in the place of invention (*Robins v. Link Belt*, 233 Fed. 1005, 148 C. C. A. 15). The fact that a patented device has had enormous sales does not dispense with all other evidence of invention. In patents of the kind before us, the

test inquiry is always, 'What will it do?' and the answer to that question in the present instance is shortly, 'It permits one to see inside.' It does nothing else, and in the claims in suit pretends to no other merit or mark of distinction."

Also, further on, at page 912:

"The commercial embodiment of this idea, when affixed to a sharpener not covered by this patent, and all sold at a cheap rate, seems neat, clean, durable, and effective; but we hold it obvious that the only part of that combination or aggregation of merits which is before us (the transparent body) does not constitute patentable invention because it did not require the inventive faculty to enlarge a window until it constituted the body of the holder."

The District Court for the Western District of New York, again by Judge Hazel, in *Cordley v. Richardson Corporation*, 278 F. R. 683, dealing with a patent for improvements in coolers for water and other potable liquids, which it held invalid, said, at page 685:

"Although plaintiff's device has come into popular favor, there must be both utility and invention to sustain a patent. Great utility not infrequently results from mechanical changes and alterations which do not embrace invention. That rule is not inapplicable in this case, inasmuch as I think there was no patentable novelty in either forming the two parts of the reservoir integrally, or making it of one piece of glass, or making it tight and rigid; for such alterations and modifications, by which better cooling and display were obtained, are thought to fall within the realm of mechanical skill, and not invention. Old devices frequently require alteration or modification to apply them to uses for which they were not originally designed or adapted, and when the court is satisfied that the changes require only the exercise of the skilled mechanic, the presumption of patentability running with the allowance of the patent is overcome."

In *Clark Mfg. Co. v. Tablet & Ticket Co.*, 18 F. (2d Series) 91, a decision by the Circuit Court of Appeals for the Seventh Circuit, opinion by Circuit Judge Evans, the court affirmed a decree for defendant under a charge of infringement of a patent for changeable signboard which was held void for want of patentable novelty, and the decision turned upon the prior art, which the court said "restricted Clark in his invention, if it did not fully anticipate him" (page 92).

In *Gerosa et al. v. Apco Mfg. Co.*, 299 F. R. 19, a decision of the Circuit Court of Appeals, for the First Circuit, District Judge Hale affirmed the decree of the lower court for defendant. The bill charged infringement of a patent for a lug for power plant support for motor vehicles, in addition to infringement of alleged trademark. Said the court, at page 24:

"The law is well understood that, in order to be an invention, an improvement must be the work of the inventive and creative faculty, and not merely the exercise of reason and experience, or the act of a mechanic skilled in the art. *Atlantic Works v. Brady*, 107 U. S. 192, 2 Sup. Ct. 225, 27 L. Ed. 438; *Thompson v. Boisselier*, 114 U. S. 1, 12, 5 Sup. Ct. 1042, 29 L. Ed. 76. In *Butler v. Bainbridge* (C. C.), 29 Fed. 142, Judge Coxe has pointed out the perplexities which surround questions of patentable invention, and that such questions cannot always be solved by examination of adjudged cases. Such cases, he says, 'serve to illuminate the paths to be traversed, but he who desires to select the right one must depend largely upon his own judgment.' Without doubt it is the duty of a court to recognize the inventor when it meets him; but it is also its duty not to extend such recognition to mere mechanical skill. It is as important to afford protection to manufacturers and mechanics in their right to employ old

devices for new situations as it is to safeguard inventors in their discoveries. Dr. Eliot, a philosopher as well as educator, teaches that fundamental trades, such as those of the carpenter, the mason, and the blacksmith, have provided valuable education for the human race, and that it is the duty of modern science to encourage those who engage in fundamental mechanics to acquire more skill in manual training and in sense-training, in order to produce results far beyond those that are now produced. Clearly it is an injustice to discourage such mechanics by granting a monopoly to patentees for doing what skilled blacksmiths have been doing for years.

We think that to grant a monopoly upon the bracket claimed to be covered by the Gerosa patent would be to prohibit automobile mechanics from continuing to do what they have done for a long time. We think no discovery or novel idea has been developed by the Gerosa patent, and that the patent must be pronounced invalid for lack of patentable invention."

And the cases along these lines are legion. Mere mechanical skill (and it is not even questionable whether that is presented in this case over the prior art) cannot be recognized as rising to the dignity of the factor of invention required by the statute. To so recognize trivial workshop or preferred practice is to put a premium upon the efforts of the speculative schemers who as a class have been condemned in the opinion of the Supreme Court in *Atlantic Works v. Brady, supra*.

We were compelled to write this brief prior to receiving the brief of appellants, and wish to make now specific rejoinder to portions of said brief where same may warrant attention.

SPECIFIC REJOINDER TO APPELLANTS' BRIEF.

On taking up appellants' brief we are impressed with a fatal insufficiency, error, viewpoint and angle of approach therein, which renders the brief as a whole out of point and inapposite to the narrow issues presented by this case. In sizing up this error in appellants' position, which we say constitutes essential trouble with their whole brief, we have only to point out that the thing of the patent in suit *is not such a structure or combination as to be capable of expressing any inventive concept, without which latter there can be no patentability.* Appellants try to apply principles and theories of law which do not fit, any more than the clothing for the articulated frame of the human being would fit the limbless form of a serpent. The group of cases cited, having to do with papermaking machines, doughnut machines, marine dredges, printing presses and the like, do not fit at all the physical subject-matter of the patent having to do with an S-shaped piece of wire. Complicated and articulated structures and combinations of elements constitute a field for the application of many interesting doctrines pertaining to invention and novelty. But these doctrines cannot be applied to such a physical issue as that before the court. We do not deny that wire can be fabricated into structures involving invention. Invention might enter into wire fence structures and wire cages and traps and the like where there is some combination and interrelation of elements resulting in a manufacture or device having mechanical performance of one kind or another, the wire serving merely as attenuated structural features. But here we have nothing new even from the consideration

of shape, nothing new from consideration of function or office, nothing new from consideration of results and nothing which is mechanical in its expression of function, that is, nothing which is kinetic. The action is merely static, just like that of the old pot hook suspending kettles. And, in addition, the prior art discloses the whole teaching of the patent in suit, so that even hair-splitting fails to support any issue of invention.

Therefore, we say that none of the law cited by appellants applies and the whole appeal thus trips and falls at the threshold.

The extended indulgence in words over this bent piece of wire that added nothing to the knowledge and assets of mankind fails to appeal to reason or justice for the above and other obvious reasons.

It is also pointed out that the brief in no manner conforms to the rules of this court as to form and arrangement.

Detail comment is perhaps in order as follows:

We know of no rule requiring the proving of want of invention beyond a reasonable doubt. As to want of novelty, that must be proven beyond a reasonable doubt, as anticipation. But it is for the court to consider, in the light of all the evidence, whether or not the presumption of presence of the quality of invention is overthrown. This does not even require the adducing of any proofs, as the court may declare a patent void for want of invention upon motion to dismiss or demurrer, as this court, in affirming the late Judge Wellborn, did in the *Towne Steering Wheel* patent case, *supra*. The position taken by appellants on page 4 is thus in error. Also by their

statement, infringement is admitted. It is not. If there be any difference between the prior art and the McGhee device, there is as much difference between defendant's device and the McGhee patented device, and by that token there could be no infringement were the patent valid.

In view of the observations and contentions just made, we deem it unnecessary to discuss the inappositeness of the authorities cited, for such will appear upon reading same. As examples, however, we may refer to the *Krauth v. Autographic Register Co.* case cited on page 6 and which considered a "combination"; and the case on the next page, *Sodemann Heat & Power Co. v. Kauffman*, which also refers to a new "combination." There is no "combination" in the McGhee patented device—no aggroupment or association of elements. It falls in the same class as tools and fasteners and other things which have no law of operation and no co-ordination of parts and features and which expresses any mode of operation or functional activity. It falls within the same class as the device in *Hookless Fastener Co. v. H. L. Rogers Co., Inc.* (C. C. A., 2d Cir), 28 F. (2d) 814, where the alleged invention was a fastener for slit and other closures, consisting of interlocking members sewn on tape and to be applied on each side of an opening, and caused to interlock by a slider moved from one end to another; in that case there was even a movable part, and the alleged invention was in making this movable slider separable so that it could be separated and the slit opened by a tearing motion from the open end, or could be moved in its reverse direction to open the slit. The court rules that there is no invention in application of such an old closing device to a slit closed at both ends, "since this was but an ex-

pected and intended use of the prior art slide fasteners.” (This comment is taken from the current number of the Journal of the Patent Office Society, page 190.) The patent was held to be void. Since there is no reorganization or no new teaching in the McGhee patent, or new structure or use, there could be no invention.

A recent case in this circuit, *Alliance Securities Co. v. J. A. Mohr & Son*, 14 F. (2d) 793, is quoted from, at page 796, on page 9 of appellants’ brief. The decree was affirmed by this court in 14 F. (2d) 799. The patent had to do with means for distributing liquids, spraying, etc., and it discussed the search of experts in spite of which the invention escaped in the realm of mechanical elements. What has such a case as that got to do with the subject-matter we are concerned with here? No expert would bother with old S-hooks.

On page 10 appellants start a discussion of what they deem misappropriation of plaintiffs’ business. The fact is there was no underlying invention to purloin. What the H. L. Judd Company did was merely to go into open competition, and in doing so they did not even exactly duplicate the McGhee hook, as will be seen by comparison. Mr. Edsall testified, as on page 14 of appellants’ brief, that the Judd Company didn’t have their patent attorney make any search for any patent to McGhee. Why should they assume it was even patentable? At any rate, whether McGhee was going to apply for patent for the present hook would not normally arouse any apprehension in a manufacturer. The truth of this is demonstrated by the decree of the lower court. Mr. Edsall frankly wrote plaintiffs regarding any such patent [Tr. p. 137], but the letter was returned unclaimed [Tr. p. 138]. So, as he

states [Tr. p. 33], he did not know of the patent in suit when the Judd Company commenced manufacture of the hooks complained of.

Appellants have considerable to say about recognition by the trade and the like, proving, as they contend, novelty and utility of the McGhee drapery hook. This crops out particularly on page 12. The fact is and the law is that one cannot transform mere mechanical skill or non-invention into invention.

In *Tubelt Co. v. Friedman et al.*, a decision by the Circuit Court for the District of New York, 158 F. 430, decree for defendant, in a suit involving an apparel belt, having to do with thread stitching, etc., the court said, pages 436-437:

“The patentee, Gaisman, in claim 6 has reproduced the belts of the prior art, substituting for the over and over stitch this old loop stitch, a well-known equivalent, except that the loop stitch, it is alleged, makes the flat seam a little firmer and flatter, and keeps the edges in better alinement, so that as the belt bends the edges are less liable to show. The effect of the stitches is one of degree only. The one, at best, is superior to the other only in that it is a little more effective. Such a substitution is not patentable invention. *Smith v. Nichols*, 21 Wall. 112, 118, 119, 22 L. Ed. 566, quoted and approved in *Burt v. Evory*, 133 U. S. 349, 358, 10 Sup. Ct. 394, 33 L. Ed. 647; *Sloan Filter Company v. Portland Gold Mining Co.*, 139 Fed. 23, 71 C. C. A. 460; *Crouch v. Roemer*, 103 U. S. 797, 26 L. Ed. 426.

In *Smith v. Nichols*, *supra*, the Supreme Court expressly decided:

‘A mere carrying forward, a new or more extended application of the original thought, a change only in form, proportions or degree, the substitution of

equivalents doing substantially the same thing in the same way, by substantially the same means, with better results, is not such invention as will sustain a patent.'

Here all we have is the substitution of an equivalent, the old and well-known loop or zigzag stitch, for the over and over stitch of many patents in this art, with better results, it is claimed, only. This, says the Supreme Court of the United States, is not invention. Merely transferring an old element to a new sphere of action, when it performs its old function in the same old way to produce the same old result, is not invention; but, if it be so transferred to meet a novel exigency and serve a new purpose, it may be. *Du Bois v. Kirk*, 158 U. S. 58, 15 Sup. Ct. 729, 39 L. Ed. 895. In *Western Electric Company v. La Rue*, 139 U. S. 601, 606, 11 Sup. Ct. 670, 672, 35 L. Ed. 294, the court held:

'While the promotion of an old device, such, for instance, as a tonsorial spring, to a new sphere of action, in which it performs a new function, involves invention, the transfer or adaptation of the same device to a similar sphere of action where it performs substantially the same function does not involve invention.'

In the case now before this court the patentee has made a belt, old in the art, by the use of the same processes and modes of construction and materials as were used in and well known to and described in the prior art; but he has substituted for the old and well-known over and over stitch, one of the things to be used in one of the several steps to be taken, the old and well-known loop or zigzag stitch, the one being the well-known equivalent of the other, doing the same work in the same way and accomplishing the same precise result, except that this result by such sewings in this belt is somewhat the better for the substitution. This sewing is an independent process in the construction of the belt, and is no wise affected or modified by, nor does it in any wise affect or modify, the other steps

in the construction or manufacture of the belt or other similar article. This substitution does not constitute or involve invention. Here we have no new or novel exigency. Here we have no new purpose to be served. The object of the sewing, the purpose to be served, is precisely the same as in the prior art, viz., 'such stitches as will allow the resulting tubular body to be flattened, so that the edges, 3a, 3b, will abut or meet,' and 'such a stitch while joining the lapped edges of the material, as shown in Fig. 4, enables said material to be flattened out in two parallel walls or webs, 3c, 3d, while the edges, 3a, 3b, can abut or meet and lie in substantially the same plane.' This is what the patent in suit says."

We quote this somewhat at length for the convenience of the court and to point our contention that even if substitutions and changes had been made by McGhee they would not under the circumstances have amounted to invention, as there was no new purpose to be served and no new or novel exigency. Also the court said along the same line, in this case in which the patent in suit failed to show patentable invention and was held void, page 439, *et seq.* :

"It will not do to find patentable invention in a device or structure where all its elements are found in the prior art, and all the alleged inventor does to produce it is to take one of the prior patented devices, and leave out one of its elements and substitute in place thereof a well-known equivalent taken from another device of the same kind, where it was used for the same purpose, operated in the same way, and produced the same results as is required in its new location, and the sole result of the substitution is that the substituted element operates or works a little better than did the displaced one, and thereby the operation of the alleged new structure is somewhat improved. This is improvement, but not invention.

It may be a successful experiment, but there is no novelty. 'While a combination of old elements producing a new and useful result may be patentable, if the combination is merely the assembling of old elements producing no new and useful result invention is not shown.' *Computing Scale Co. of A. v. Automatic Scale Co.*, 204 U. S. 609, 27 Sup. Ct. 307, 51 L. Ed. 645. To constitute improvements in invention they must be the product of original conceptions. *Pearce v. Mulford*, 102 U. S. 112, 118, 26 L. Ed. 93; *Slawson v. Grand Street Railway*, 107 U. S. 649, 2 Sup. Ct. 663, 27 L. Ed. 576; *Munson v. N. Y. City*, 124 U. S. 606, 8 Sup. Ct. 622, 31 L. Ed. 586.

Here complainant contends that its belt as a whole, a completed thing, is made better, more durable, more attractive, more salable by reason of the substitution; but conceding all this to be true, patentable novelty is not shown. The better result does not show invention. *Smith v. Nichols and Western Electric Co. v. La Rue*, *supra*. Its greater utility, durability, attractiveness and marketability do not of themselves show patentable novelty. These facts are evidence on the subject, and in very doubtful cases may be persuasive and turn the scale in favor of the patentability of the device. A valid patent must combine utility, novelty, and invention. Neither large sales nor popularity or effectiveness of itself shows patentable invention. Nor do all these combined establish it. See *Duer v. Corbin Co.*, 149 U. S. 216, 223, 13 Sup. Ct. 850, 37 L. Ed. 707; *Richards v. Elevator Co.*, 159 U. S. 477, 487, 16 Sup. Ct. 53, 40 L. Ed. 225; *American Sales Book Co. v. Bullivant*, 117 Fed. 255, 54 C. C. A. 287; *McClain v. Ortmyer*, 141 U. S. 419, 429, 12 Sup. Ct. 76, 35 L. Ed. 800; *Union Biscuit Co. v. Peters*, 125 Fed. 601, 609, 60 C. C. A. 337; *Falk Mfg. Co. v. Missouri R. Co.*, 103 Fed. 295, 43 C. C. A. 240; *New Departure Bell Co. v. Bevin Bros. Mfg. Co.*, 73 Fed. 469, 19 C. C. A. 534; *Dodge Coal Storage Co. v. N. Y. C. & H. R. R. Co.*, 150 Fed. 738, 80 C. C. A. 404. In *New Departure Bell Co. v. Bevin Bros. Mfg. Co.*, *supra*, Judge Lacombe said:

'But this precise mechanism was described and published to the world in the Bennett patent, and is used in complainant's belt with no other reorganization of operative parts than the insertion of an additional gear and pinion wheel, and such a shifting of the spring as introduces no new function. In our opinion such unsubstantial changes do not involve invention.'

In *Dodge Coal Storage Co. v. N. Y. C. & H. R. R. Co.*, *supra*, Judge Townsend said:

'The would-be inventor or designer of novel mechanism for accomplishing these objects, therefore, is presumed to have before him the whole field of the art of the engineering construction applicable to the collection and removal, the elevation, and conveyance of such materials from one point to another. And the question here presented is, not what these particular patentees may actually have invented, but whether the state of the art in such engineering field was such that it would require invention to construct such apparatus, or to adapt the constructions known in the art to the exigencies of a particular situation, or the requirements of a certain class of materials. * * * We conclude, therefore, that the patentees did not devise any novel means by which to carry out their ideas and put them in shape for practical operation.'

In *McClain v. Ortmyer*, *supra*, the court said:

'This court has held in a number of cases * * * that in a doubtful case the fact that a patented article had gone into general use is evidence of its utility. It is not conclusive even of that—much less of its patentable novelty.'

Scores of pertinent quotations might be made, but it is not necessary. The complainant's belt is exceedingly attractive and neat. Evidently, so far as the evidence discloses, it is of great utility and the best on the market, but these facts do not prove patentable invention.

In view of the prior art and prior well-known uses, the complainant's patent fails to show patentable invention and is void.

There will be a decree for the defendant dismissing the bill, with costs."

As was said in *American Ldy. Mch. Mfg. Co. v. Adams Ldy. Mch. Co.*, 161 F. 556, 563:

"To hold that a combination of old and well-known elements in the old way with some modifications to which the skill of the ordinary mechanic skilled in the art is adequate, unless to meet a new and novel exigency, is patentable for the reason the benefit to mankind is valuable and extensive, is to reward every mechanic for exercising his skill, not his mental conceptions, by a monopoly, and a misconception and works a perversion of the patent laws."

It was said in *Archer et al. v. Imperial Mach. Co.*, 202 F. 962, that doing substantially the same thing in the same way by substantially the same means, but with better results, is not such invention as will sustain a patent.

In *Harvey Hubbell Inc. v. Fitzgerald Mfg. Co.*, 283 F. 790, the Hubbell patent for a separable attachment plug for electrical connections was held void for lack of invention, although a useful thing and capable of production economically and at reduced cost and likewise commercially successful.

In *Columbia Metal Box Co. v. Halper*, 220 F. R. 912, a decision of the Circuit Court of Appeals for the Second Circuit, involving a patent for a sheet metal junction box for use in electric wiring, such patent was held void for want of invention, and the court said, page 914, *et seq.*:

“In *Magowan v. New York Belting Co.*, 141 U. S. 332, 343, 12 Sup. Ct. 71, 35 L. Ed. 781 (1891), the fact was remarked, and evidently had much weight, that the patented product went at once into such an extensive public use, as almost to supersede products made for a like purpose under other methods. That fact was regarded as pregnant evidence of its novelty, value, and usefulness. And this success was attained, although the new product was put upon the market at a price from 15 to 20 per cent higher than the older products, notwithstanding it cost 10 per cent less to produce it.

The question which the trial court considered was whether the adaptation of a form of hinged cover not wholly unknown to the peculiar requirements of the new art of electric wiring constituted invention. At the first hearing the court stated that it did not appear that the form of hinging shown by the patented device had ever before been used for the purpose sought by the inventor. And it concluded that the method of hinging used produced a tight cover without the use of the strap or butt hinges. While thinking this a small thing, the court declared it useful and desirable, a novel and meritorious device, and sustained the patent. On rehearing, after the introduction in evidence of the General Electric cast metal box, the trial court reached the conclusion that the very form of cover which the patentee of the patent in suit claimed as new had been used for electric wiring purposes before the earliest invention date claimed by complainant.”

So, in the case at bar, every aspect of the simple thing of the patent, and the very form thereof, was old in the art prior to McGhee’s date of alleged invention.

In *Gilchrist v. F. B. Mallory Co.*, decision of the District Court, District of Oregon, 281 F. 350, District Judge Bean said, where there was even an apparently new element introduced (p. 351, *et seq.*):

“All other elements of the claims in question are old in the art, and in the Gilchrist pulley they do not perform any new function or have any new mode of operation, or produce any new result, and therefore the combination of them in one device is not invention.

‘The combination, to be patentable, must produce a different force or effect, or result in the combined forces or processes, from that given by their separate parts. There must be a new result produced by their union: if not so, it is only an aggregation of separate elements.’ *Reckendorfer v. Faber*, 92 U. S. 347, 23 L. Ed. 719.

See, also, *Hailes v. Van Wormer*, 20 Wall. 353, 22 L. Ed. 241; *Palmer v. Corning*, 156 U. S. 342, 15 Sup. Ct. 381, 39 L. Ed. 445; *Thatcher Heating Co. v. Burtis*, 121 U. S. 286, 7 Sup. Ct. 1034, 20 L. Ed. 942; *Jackson Skirt & N. Co. v. Rosenbaum*, 225 Fed. 531, 140 C. C. A. 515.

Oil reservoirs in pulley sides are old in the art, as shown by the Morgan, Ludford and Labadie patents. Indeed, the Morgan patent reads substantially letter perfect with claim 1 of complainant’s patent. It is true the oil reservoir in the Morgan pulley is formed by a plate riveted on the side and not cast as an integral part of it, as in complainant’s device. It, however, is for the same purpose, operates and functions in the same way, and produces the same result by retaining oil and lubricating the bearing pin as in complainant’s patent, and it was not invention for complainant to make the side in one piece, thus combining the separate parts of the Morgan patent, since there is no substantial change in function, operation or result. *Ft. Pitt Supply Co. v. Ireland & Matthews Mfg. Co.*, 232 Fed. 871, 147 C. C. A. 65; *Enterprise Mfg. Co. v. Shakespeare Co.*, 220 Fed. 304, 136 C. C. A. 138; *Crier v. Innes (C. C.)* 160 Fed. 102; *Huebner-Toledo Breweries v. Mathews Grav. Car Co.*, 253 Fed. 433, 165 C. C. A. 177; *Machine Co. v. Murphy*, 97 U. S. 120, 24 L. Ed. 935; *R. R. Supply Co. v. Elyria I. & S.*, 244 U. S. 285, 37 Sup. Ct. 502, 61 L. Ed. 1136.

In reaching this conclusion, I am not unmindful of the presumption of the validity of the patent arising from its issue, or that the auto-lubricating block manufactured by plaintiff has proven its superior utility in the logging business.

‘But a mere carrying forward or new or more extended application of the original thought, a change only in form, proportions, or degree, the substitution of equivalents, doing substantially the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent.’ *Smith v. Nichols*, 88 U. S. (21 Wall.) 119, 22 L. Ed. 566.

And ‘the advantages claimed for it (the Gilchrist device), and which it no doubt possesses to a considerable degree, cannot be held to change this result, it being well settled that utility cannot control the language of the statute, which limits the benefit of the patent law to things which are new as well as useful. The fact that the patented article has gone into general use is evidence of its utility, but not conclusive of that and still less of its patentable novelty.’ *Grant v. Walter*, 148 U. S. 556, 13 Sup. 702, 37 L. Ed. 552.

See, also, *McClain v. Ortmyer*, 141 U. S. 419, 12 Sup. Ct. 76, 35 L. Ed. 800; *Hollister v. Benedict & Burnham Mfg. Co.*, 143 U. S. 59, 5 Sup. Ct. 717, 28 L. Ed. 901; *Smith v. Nichols*, 21 Wall. 112, 22 L. Ed. 566; *Edwards v. Dayton Mfg. Co.*, 257 Fed. 980, 169 C. C. A. 130; *Herzog v. Keller Co.*, 234 Fed. 85, 148 C. C. A. 101; *Huebner-Toledo Breweries v. Matthews Gravity Carrier Co.*, *supra*; *Klein v. Seattle*, 77 Fed. 220, 23 C. C. A. 114.

The question whether a patent involves invention is one of fact for the court, to be answered in the light of all the pertinent considerations, including the prior art, and, so viewing the complainant’s patent, I am of the opinion that it is invalid for want of invention.”

There are lots of things which fill a long-felt want which do not smack of invention. Articles which are stronger, more compact in form, better in appearance and the like, fill long-felt wants but myriads of them are produced without recognition by the Patent Office.

While the Tonks catalogue was in the possession of the Judd Company for years prior to the McGhee invention, the records show plainly that it was in the New York office and not in the Connecticut factory which was in charge of Mr. Edsall. [Tr. p. 33.] Whether it was or was not, has nothing to do with the proper entry of the Judd Company into competition with appellants, and there was no reason why any article in the Tonks catalogue should be put out in this country by the Judd Company or anyone else at any particular time. Obviously these devices were made and sold abroad and the manufacture was taken up here by McGhee and then by the Judd Company, both of whom under the law are chargeable with or to be credited with notice of prior accomplishments in the art in which they were working.

At the bottom of page 14 appellants make an absolutely erroneous statement to the effect that drapery hooks before McGhee's invention had to be sewed on to the draperies. This is neither true of the Tonks or Whitehouse catalogue hooks or even of the hooks of McGhee's prior patent. Even the Ashmore patent under which the rights were possessed by the Judd Company was not a sew-on hook. McGhee could not get a second patent in any sense monopolizing this feature, after his first patent had disclosed it. As to the matter at the top of page 15, we are in agreement with appellants that the McGhee device is merely an S-shaped hook pointed at one end.

With respect to the matter on page 15, in view of the file wrapper and contents the claim of the McGhee patent is to be construed to mean and be a Chinese copy in words of the thing in the drawing of the patent. Appellants admit that this claim is a “pen picture of the drawings of the patent”. There are differences between plaintiffs’ commercial device and also the defendant’s device. As we have said, they are perhaps further from the patented device than the prior art devices, so neither plaintiffs nor defendant are practicing the exact teaching of the McGhee patent.

As to the discussion of the various prior art patents and devices, which is indulged in in appellants’ brief, we will make no attempt here to correct implications and suggestions and theories therein which we do not consider to be accurate. We beg to submit that in our discussion of these things, *supra*, we have dealt fairly and clearly and accurately with them and we think that Your Honors will clearly understand them and their pertinence in consideration of this brief.

As to the British patent to Harrison, discussed at pages 19 and 20, it is clearly deducible that the position appellants take is that McGhee omits certain things that the Harrison patent shows. Such omission does not change the mode of operation or use and no invention could result from such omission. In the discussion of the Ashmore patent, page 21, *et seq.*, clearly the Ashmore hook can swing, and it makes no difference whether it be hooked over a rod or ring as far as any invention, if present, is concerned. Also, this Ashmore hook is in the same class as the McGhee hooks of both McGhee patents, namely, it is a non-sew-on hook.

An erroneous statement is made with carelessness, on page 23, that “all of the devices pictured on the respective pages of the catalogues” are to be used in connection with curtain pole rings and could not be used as is substantially the identical thing of the McGhee patent. Self-refutation of this statement is made further on when counsel say: “These catalogues contain no description of manner of use.” And we do not understand why it “would be impossible to take any one of these three devices and use them as plaintiffs’ drapery hook is used”. Certainly, practically identical things can be used in substantially identical manner, particularly where there is no countervailing factor to prevent it. The brief then goes on to talk about changing these hooks to render them “capable of performing the functions of plaintiffs’ patented device”. This is to us a most remarkable gesture and is without any foundation in structure. As the catalogue hooks are so closely like the McGhee patented hook that they could be mixed with the latter in the same box and no one would discover the difference in withdrawing and using them, somewhat definite pointing out of the substantial changes necessary to be made in them, to make them usable as the McGhee hooks are used, certainly is in order from appellants. One might as well say that a belt and buckle for a thin man could not anticipate one large enough for a stout man. Speaking again of the catalogues, the picture of a common, simple bent piece of wire with clear form—an S-hook—needs no legend to tell us what it is. It speaks for itself, particularly in view of its classification in those catalogues. It makes no difference whether the catalogue devices were ever known and used in this country. Publication in the catalogue is

sufficient under the law. The citation of authority from Your Honor's opinion in *Carson v. American Smelting & Refg. Co.*, appearing on page 26, is very inapt. The rule set down by Your Honors applies where any uncertainty exists. There could be no uncertainty here. Description of the foreign catalogue hooks would be useless and unnecessary to any grammar grade school boy. Any housekeeper wishing to hang curtains could surely cut and sharpen wire and fashion hooks therefrom like these Tonks etc. catalogue hooks, wherewith to hang her curtains. She would need no teaching from any expert or mechanic. So, with respect to these Tonks, etc. catalogue disclosures, appellants are merely urging this court to believe there is some magic in the length of a piece of bent wire, or the fullness or thinness of the loops thereof or the sharpness of the point thereon. There is none of the tang of invention in any of these aspects and characteristics. What better authority than that at the bottom of page 28 for the integrity of the prior art in this case in its elimination of the quality of invention from the bent wire of the McGhee patent? There is not a structural difference between Tonks and McGhee. They are closer together than neighboring blades of grass. These bent wire affairs are too simple in nature to be chargeable with harboring any critical or connoted "principle" or "mode of operation". There is not enough subtlety in them to intrigue a kindergarten child. Obviously the foreign catalogues went to people in trades handling these things. They fully comply with requirements of the law as to prior publication.

The authority at the top of page 31 is not in point. The Tonks *et al.* catalogues were circulated and were pub-

lic documents and no words were needed to describe the things therein shown. The catalogue classifications are enough for purposes of instruction. This ancient decision from federal cases is not today's law on such matters. The *Union Tool Co. v. Wilson & Willard Mfg. Co.* case cited at the bottom of this page dealt with a patent for an underreamer, and a cut could not show the internal working parts. There is nothing such to be concealed in a bent wire. The decree in that case was reversed on the main issues by Your Honors, as reported in 249 F. R.

However, such a catalogue is a public work, and a cut alone where no description is necessary to make its disclosure clear is sufficient of a publication in such a catalogue. This has been very recently decided by no less a patent law authority than the Hon. Learned Hand, Circuit Judge, in a decision of the Circuit Court of Appeals of the Second Circuit in *Jockmus v. Leviton, et al.*, 28 F. (2d) 812, 813, et seq., where the court said, reviewing the law, including *Reeves v. Keystone Bridge Co.*, cited by appellants here:

“We are content to follow the ruling in *Imperial Glass Co. v. Heisey*, 294 F. 267 (C. C. A. 6), that a catalogue distributed generally to a trade is a publication within Revised Statutes, Sec. 4886, 35 U. S. C. A., Sec. 31. It may indeed be that such a document was not a ‘public work’ under the act of 1836 (5 Stat. 117), and that *Parsons v. Colgate* (C. C.) 15 F. 600, was rightly decided, though the brief comment in the opinion does not take the distinction. *Reeves v. Keystone Bridge Co.*, 20 Fed. Cas. 466, No. 11,660, only threw out a doubt, and went off on another point. While it was laid down without discussion in *New Process Fermentation Co. v. Koch*, (C. C.) 21 F. 580, 587, that circulars were not publications, it was unnecessary to the decision and certainly was not its chief reliance. *Britton v. White Mfg. Co.*, (C. C.)

61 F. 93, was decided without discussion, and on the authority of the three cases, just cited, which support it only so far as we have said. The aggregate of these authorities is not so imposing as to cause us any hesitation in following the Sixth Circuit. On principle we are entirely in accord, for the purpose of the statute is apparent, and we ought to effect it so far as its language will allow. While it is true that the phrase, 'printed publication', presupposes enough currency to make the work part of the possessions of the art, it demands no more. A single copy in a library, though more permanent, is far less fitted to inform the craft than a catalogue freely circulated, however, ephemeral its existence; for the catalogue goes direct to those whose interests make them likely to observe and remember whatever it may contain that is new and useful.

Whether the cut, No. 712, in Gogarten & Schmidt's 1908 catalogue, was a sufficient disclosure is another matter. If the claims be strictly limited, it certainly was not, because it did not show how the end of the upper leg was fastened to the stud—whether as the plaintiff does it, or as the defendant, or in some other way. But, if the claims be read as they must be to cover the supposed infringement, we do not see what can be thought missing. That it was an adjustable candle socket the text itself declares; how its adjustment was to be made the cut makes plain beyond chance of mistake. The socket at the top is plainly for a bulb and the screw thread at the bottom to fit upon the pipe terminal. The jacket was represented by figures 713 and 714, and the whole of this very simple invention was before the reader at a glance. We know of no rule that figures can never of themselves be an adequate anticipation of mechanical inventions, as of course they must be of designs, and we can see no reason for importing into the statute an arbitrary distinction, unrelated to its purposes, *Keene v. New Idea Spreader Co.*, 231 F. 701, 708 (C. C. A. 6); *Huebner v. Mathews*, 253 F. 435, 444 (C. C. A. 6). Words have their equivocations quite as much as figures; the question always must be what the art necessarily gathered from what appeared.

Whether the catalogue was in fact distributed generally, and when, are different questions. That it was printed in 1908 no one can reasonably doubt; it was a trade catalogue, meant to pass current for a season and to be superseded, as its successor of 1910 in this very case bears witness. To suppose that it bore an earlier date than that at which it first appeared contradicts all we know about merchandising; it might be post-dated like a motor car but never the opposite. It is of course conceivable that, though printed, it was never distributed, or that the distribution was too limited to be a 'publication.' As to the last we can scarcely undertake to set a limit. Schmidt says that perhaps 1,000 went out. Far less would have served; the 50 which was his lower limit were quite enough. To be sure the fact of any distribution at all rests upon the uncorroborated testimony of him and Scharpe, because there was further documentary corroboration of neither, though each was explicit in his recollection, and each had had first hand knowledge. This would not be enough, if the catalogue itself were not produced, bearing its own evidence of existence since 1908, but no one can seriously suppose that such a document, printed in quantity, was intended to be kept secret; its whole purpose was to be spread broadcast as far as possible. It had been printed at some expense in French for French customers, and, unless some accident happened to prevent, it would in due course have gone upon its intended errand. To prove that no accident did happen, and that it did reach its destination we have, it is true, only oral, though entirely disinterested, testimony; but it is a mistake to assume that, even under the extraordinarily severe tests applied to the proof of anticipation, every step must be buttressed by documents. That some documents are necessary, perhaps, may be the rule; but, when the documents go so far as here, the ritual, if there is any, is satisfied, and the question is merely whether any doubt remains. We think that to entertain a scruple in a case so fortified is to catch at straws."

Surely, the Tonks *et al.* catalogues are fully proper evidence.

Again we point out with respect to the matter on page 32 that the witness Vroom was in the office in New York which had nothing to do directly with the production at the factory; and although he said he got no inspiration from the catalogue himself, he was not looking for any, and as a matter of fact no one needed any to make this old S-shaped hook. This is the only testimony from defendant's witnesses which appellants vouchsafed to rely upon and it is self-explanatory for the above reasons. Where is there any testimony that all of the Judd Company people scanned these catalogues for inspiration or otherwise? Appellee merely went into competition with appellants in an open field which had been invaded by that type of patent condemned by the Supreme Court in *Atlantic Works v. Brady*, 107 U. S. 192—a field just as open as that in which the old-time clothes pin was manufactured by competing interests. It required no inventive act to give either party directions for such manufacture.

We still await any definition of the alleged *conception* of McGhee. Appellants, with the prior art and wire-bending obviousness before them, dare not, we think, to attempt such a definition. And we assert that this alone is an answer to the whole appeal in this case.

The decree of the lower court, we submit, should be affirmed, with costs for appellee.

Respectfully submitted,

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